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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/004,758	12/04/2001	Donald J. Monroe	10541-636	8286

29074 7590 10/10/2003

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EXAMINER

RODRIGUEZ, PAMELA

ART UNIT	PAPER NUMBER
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3683

DATE MAILED: 10/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

8K

Office Action Summary	Application No. 10/004,758	Applicant(s) MONROE ET AL.	
	Examiner Pam Rodriguez	Art Unit 3683	

-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) 8, 18 and 22-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9-17 and 19-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>4 & 5</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Group 1, Species A in Paper No. 7 is acknowledged.
2. Claims 8, 18, and 22-33 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Group/species, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 7.

Claim Objections

3. Claims 1 and 15 are objected to because of the following informalities: in the last line of Claim 1 the phrase "a primary edge" should read —the primary edge—to be consistent with the previously used claim terminology and to avoid a potential 35 U.S.C. 112 second paragraph issue and in the last line of Claim 15, the word "so" should be deleted. Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. Claim 20 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In lines 1 and 2 of Claim 20, the phrases "each groove" and "each primary edge" are indefinite. The word "each" implies more than one groove and more than one

primary edge be present and previously claimed. However, Claim 15, from which Claim 20 depends therefrom, only recites one of each component. Therefore, it is unclear whether applicant is claiming a plurality of grooves and a plurality of primary edges or just one of each component.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-7, 9-17, and 19-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Johnston.

Regarding Claim 1, Johnston discloses a pinion 14/18 moveable along an output shaft 10 of a starter assembly (see Figures 1 and 2) having all the features of the instant invention including: the pinion 14/18 having an inner surface 24 disposed about the output shaft 10 (see Figures 1 and 2, wherein since bushing 18 is integral with pinion 14, the inner surface is readable as the inner surface 24 of pinion bushing 18), the inner surface extending to an end face of the pinion 14/18 (see Figure 1, wherein the bushing inner surface 24 extends to the end faces of the pinion), wherein the pinion 14/18 comprises a primary edge (see Figure 2 and the middle groove 20, wherein the primary edge is readable as the right top edge of that groove nearest the top lead line of element numeral 24) for moving particles from the shaft 10 as the pinion 14/18 moves

along the output shaft (see column 3 lines 6-13), the primary edge being formed along a length of the inner surface (see Figure 2) and extending to the end face (see Figure 2), the primary edge defining a groove 20 in which the particles are received as the pinion 14/18 moves along the output shaft (see column 3 lines 6-13), and wherein the groove 20 is formed along the length of the inner surface 24 and adjacent a primary edge (see Figure 2).

Regarding Claim 2, Johnston further discloses that the pinion 14/18 is a one-piece pinion (readable as such, since in column 1 lines 67-68, the pinion 14 and bushing 18 are press-fit together and move together, thus the two parts are integral, and form a one-piece structure).

Regarding Claim 3, see column 1 line 58 – column 2 line 1.

Regarding Claim 4, see column 1 lines 58 et al.

Regarding Claim 5, Johnston further discloses a secondary edge for moving the particles from the primary edge, the secondary edge being radially formed on the end face adjacent the primary edge (see Figure 2 and the middle groove 20, wherein the secondary edge is readable as the right bottom edge of that groove nearest the bottom lead line of element numeral 24).

Regarding Claim 6, see column 3 lines 6-13.

Regarding Claim 7, see Figure 2.

Regarding Claim 9, see the plurality of grooves 20 on the inner surface 24 shown in Figure 2 and note how each groove has its own separate primary edge as described in Claim 1 above.

Regarding Claim 10, see grooves 20 in Figure 2, each formed along the length of the inner surface 24 and adjacent each respective primary edge.

Regarding Claim 11, see Figure 2.

Regarding Claim 12, see Figure 2.

Regarding Claim 13, note how at least bushing 18, which is integral with pinion 14, is made of metal as disclosed in column 2 lines 6-7.

Regarding Claim 14, see the barrel portion shown in Figure 1 and a gear portion (see Figure 1 and the portion of pinion 14/18 labeled element numeral 14), wherein the end face and the inner surface 24 are adjacent the gear portion (see Figures 1 and 2).

Regarding Claim 15, see Claims 1 and 11 and note the bore of bushing 18 being readable as the bore of the inner surface 24.

Regarding Claim 16, see Claim 5 above.

Regarding Claim 17, see groove 20 of Figure 2 and column 3 lines 6-13.

Regarding Claim 19, see Figure 2 and grooves 20.

Regarding Claim 20, see Claim 10.

Regarding Claim 21, see Figure 2.

Conclusion

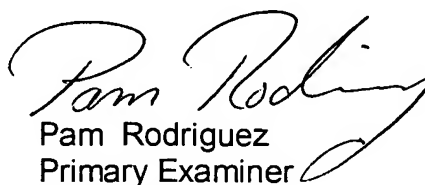
7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Tanaka discloses a pinion for a starter assembly having a groove to receive a seal for preventing the entrance of dirt or contaminants into the starter assembly.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pam Rodriguez whose telephone number is 703-308-3657. The examiner can normally be reached on Mondays 6 am -4 pm and Tuesdays 6 am -12 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Lavinder can be reached on 703-308-3421. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.


Pam Rodriguez
Primary Examiner
Art Unit 3683
10/6/03

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10/6/03